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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/452,658	05/25/1995	WALTER C. FIERS	B8/B8-CIP-DI	5499

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EXAMINER

MARTINELL, JAMES

ART UNIT PAPER NUMBER

1634

DATE MAILED: 09/26/2005

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 08/452,658
Filing Date: May 25, 1995
Appellant(s): Walter C. Fiers

James F. Haley, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 24, 2005 appealing from the Office action mailed May 28, 2004.

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(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows.

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Appellant states (brief, page 4, section VI) that claims 31, 33, and 34 are rejected under 35 U.S.C. § 102(g). This is incorrect. Claims 31 and 34 are rejected under 35 U.S.C. § 102(g). Claim 33 was not rejected under 35 U.S.C. § 102(g) because the nucleotide sequence recited in claim 33 differs at codon 30 from the nucleotide sequence in the Sugano et al patents at one nucleotide. In Sugano et al '859, Table 5, columns 11-12 codon 30 is "TAT" (encoding TYR, tyrosine), in Sugano et al, '567, Table 5, columns 11-12 codon 30 is "TAT" (encoding TYR, tyrosine), and in claim 33 of the instant application codon 30 (*i.e.*, nucleotides 88-90) is "TAC" (encoding TYR, tyrosine).

NEW GROUND(S) OF REJECTION

Claims 31 and 34 are rejected as being unpatentable under *res judicata*.

GROUND(S) OF REJECTION NOT ON REVIEW

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief.

Claims 31, 33, and 34 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 37 of copending Application No. 08/253,843 and claims 31, 33, and 34 of copending Application No. 08/449,930. Appellant has agreed to file one or more appropriate Terminal Disclaimers or to cancel conflicting subject matter (see the response filed November 24, 2004, page 2, last full paragraph).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Sugano et al, U.S. Patent No. 5,514,567, issued May 7, 1996.

Sugano et al, U.S. Patent No. 5,326,859 issued July 5, 1994.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 31 and 34 are rejected under 35 U.S.C. § 102(g) as being clearly anticipated by either one of Sugano et al (U.S. Patent No. 5,514,567) or Sugano et al (U.S. Patent No. 5,326,859). Each of the Sugano et al patents discloses a DNA that encodes the same amino acid sequence as is recited in claim 34 of the instant application (*e.g.*, see Table 5 at columns 11-12 in each of the references). Additionally the DNA in Table 5 of each of the Sugano et al references would hybridize to the DNAs mentioned in claim 31 of the instant application because the DNA in Table 5 of each of the Sugano et al references differs by only one nucleotide (at codon 30) from the DNA recited in claim 33 of the instant application) and also encodes a beta-interferon. Thus, the DNA of Sugano et al is embraced by claim 31, parts 1) (a) and 1) (b) of the claim. The use of beta-interferon to stimulate the immune system in the treatment of human cancers and for viral diseases is disclosed in each of the Sugano et al references at column 1, lines 10-30) and the expression of DNA encoding beta-interferon in heterologous non-human hosts is taught in Sugano et al '567 at column 15 and claims 21-31 and in Sugano et al '859 at column 16. Thus, the methods taught in each of the Sugano et al references are embraced by claims 31 and 34 of the instant application. The U.S. Court of Appeals for the Federal Circuit concluded (*Fiers v. Sugano*, 25 USPQ2d 1601, U.S. Court of Appeals for the Federal Circuit, decided January 19, 1993),

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that Sugano is entitled to rely on his disclosure as enabling since it sets forth the a detailed teaching of a method for obtaining a DNA coding for β -IF and the Board did not err in determining that Fiers presented no convincing evidence impeaching the truth of the statements in Sugano's patent specification. We also conclude that Sugano's application satisfies the written description requirement since it sets forth the complete and correct nucleotide sequence of a DNA coding for β -IF The Board correctly determined that Sugano's March 19, 1980 Japanese application satisfies the requirements of section 112, first paragraph, and that Sugano thus met his burden to establish entitlement to that filing date.

Appellant's arguments (brief, pages 4-6) are not convincing. Appellant complains that there is no evidence of record to indicate that Sugano et al had completed an actual reduction to practice of the invention in this country prior to appellant's effective U.S. filing date. The instant application and the two Sugano et al patents disclose the same amount of information relevant to the methods claimed in the instant application. Appellants have not disagreed with this fact. Since the Court of Appeals for the Federal Circuit has already determined that Sugano et al are entitled to priority (Fiers v. Sugano, 25 USPQ2d 1601, Fed. Cir. 1993) for what is for interference purposes a patentably indistinct invention, the rejection under 35 U.S.C. § 102(g) should be sustained.

NEW GROUND(S) OF REJECTION

Claims 31 and 34 are rejected as being unpatentable under *res judicata*. The discussion in the rejection under 35 U.S.C. § 102(g) is incorporated here. A judgement against appellant in connection with priority of invention relative to that of Sugano et al (*e.g.*, see Sugano et al (U.S. Patent No. 5,514,567) and Sugano et al (U.S. Patent No. 5,326,859) for what is a patentably indistinct invention is of record (Fiers v. Sugano, 25 USPQ2d 1601, Fed. Cir. 1993). Accordingly, appellant is estopped from receiving a patent for the instant claims. See also *In re Deckler* (24 USPQ2d 1448, Fed. Cir. 1992).

(10) Response to Argument

The response to appellant's arguments are contained in section (9) above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:


(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

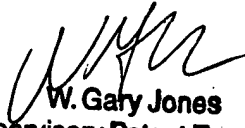
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Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,



James Martinell
Primary Examiner
Art Unit 1634


9/12/05


W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Conferees:


MICHAEL P. WOODWARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600


JASEMINE C. CHAMBERS
DIRECTOR
TECHNOLOGY CENTER 1600